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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,649	08/08/2001	John F. Flannery	072677.00001	5521

33221 7590 02/08/2006

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EXAMINER

BEKERMANN, MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/924,649	FLANNERY ET AL.	
	Examiner	Art Unit	
	Michael Bekerman	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08/08/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/8/01 and 7/23/02</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 1: 21 and 22, Figure 3: 107 and 110, Figure 5: 129 and 130. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 16 recites the limitation "connectionless", which is not referenced in the specification. Examiner considers a connectionless communication to be a regular communication.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear as to what the term "connectionless communication" means. In the interest of applying prior art, Examiner considers connectionless communication to be a regular communication.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 16 recites the limitation "switch" in the second line. There is insufficient antecedent basis for this limitation in the claim. Examiner reads a switch to be a router.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1, 2, 4-19, 21, 24-26, 28, 29, 32, and 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Kamel (U.S. Patent No. 5,937,037).** Kamel teaches the sending of audio advertisements to users of a prepaid audio communications service that contains all the limitations recited in the above claims.

Regarding claims 1, 24, 34, and 36, Kamel teaches the receiving of a personal identifier input from a user of a first communications unit (Column 10, Lines 1-5), the determining based on a personal identifier if the user is authorized to communicate with a further communication unit (Column 10, Lines 1-5), the sending of a first message advertising a service to the first communications unit (Column 10, Lines 16-18) based on the personal identifier (Column 7, Lines 34-37), and the receiving of a reply in response to the first message indicating whether the user wants to receive further information about the offered service (Column 10, Lines 18-21). The user may also communicate a further identifier for a second phone (the phone number of the further communication unit) (Column 10, Lines 6-15). The service number is taken to read on the 800 number the user dials to communicate with the system.

Regarding claims 2, 18, and 29, Kamel teaches the putting of the first communications unit in communication with a provider of further information about the offered service (Column 13, Lines 23-25).

Regarding claims 4, 28, and 35, Kamel teaches the first communications unit as being a telephone (Column 11, Lines 32-36), the personal identifier as being a PIN (Column 10, Lines 1-5), the determining of whether the user is authorized to communicate with the further communications unit (Column 10, Lines 1-5), and the determining of what content to send to the communications unit (Column 7, Lines 34-37).

Regarding claim 5, 25, and 26, Kamel teaches the sending of an audio spot advertisement or a visual format advertisement containing information about a product offer (Column 11, Lines 32-36).

Regarding claim 6, Kamel teaches the receiving of a prompt signal as a request for further information about a product for sale, and the placing of the user in communications with a customer service entity (Column 13, Lines 16-25).

Regarding claims 7, 8, 10, 11, Kamel teaches giving the advertiser multiple options for how frequent they want their advertisements to play (Column 12, Lines 55-61). Kamel also teaches multiple ad spots as being used (Column 13, Lines 5-8), the sending of a prompt reply as an indication that the user wants to be sent a further audio spot ad, the receiving of a prompt reply in response to the prompt, and the sending of the further audio spot ad (branching to optional message segments is taken to read on longer messages) to the first communications unit (Column 13, Lines 5-8).

Regarding claim 9, Kamel teaches saving use information about each advertisement in a message history database (Column 17, Lines 52-60).

Regarding claim 12, Kamel teaches a user data store capable of storing and retrieving user information (Column 17, Lines 52-53), an ad data store capable of storing and retrieving ad information (Column 18, Lines 18-19), and a network communications processor in communication with the user data store and the ad data store that is capable of accepting a communications request to place a first communications unit in contact with another communications unit and providing a targeted advertisement to a user (Column 10, Lines 1-22).

Regarding claim 13, Kamel teaches the communication units as being telephones (Column 11, Lines 32-36), the personal identifier as being a PIN (Column 10, Lines 1-5), and the network communication processor comprising a telephone activity management server in networked communications with the user data store and ad data store (Column 23, Lines 4-7).

Regarding claims 14-16, 19, and 21, Kamel teaches a bridging switch and a response unit (Column 13, Lines 60-67 and Column 14, Lines 1-2). The bridging switch is capable of placing two telephones in communications with each other (Column 23, Lines 13-20). Kamel's system teaches that two telephones will not be placed into communications with each other unless a PIN has value associated with it (from listening to advertisements). Kamel also teaches a PIN Validation Director (Column 10, Lines 1-5) and an Ad Director performing the steps as outlined by claims 15, 16, and 19 (Column 10, Lines 16-21 and Lines 36-45).

Regarding claim 17, Kamel teaches an audio response unit capable of supplying an advertisement (inherently an intelligible audio message) to a telephone and receiving feedback prompts from the telephone (Column 10, Lines 16-21).

Regarding claim 32, Kamel teaches entering a destination telephone number before the advertisement is played (Column 10, Lines 6-15).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 20, 27, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamel (U.S. Patent No. 5,937,037).**

Regarding claim 20, Kamel teaches a first message as being sent before the two parties are connected, and interrupting the call with another message after the parties have been connected (Column 10, Lines 36-45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to send any number of advertisements at any time during the call. This will ensure that a user has heard every advertisement the system wishes them to hear.

Regarding claim 27, Kamel teaches the use of screen phones (Column 21, Lines 18-23). Official notice is taken that touch screens are old and well-known in the art. It would have been obvious to one having ordinary skill in the art at the time the

invention was made to use the invention of Kamel with, not only a phone with a video screen, but also a video phone implementing a touch screen. This would widen the market for which this product would be useful.

Regarding claims 30 and 31, Kamel doesn't specify how a PIN number is to be assigned. Official notice is taken that phone cards are old and well-known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the toll number and the PIN number to the user with a phone card, so the users will have the card to place in their wallets.

11. Claims 3, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamel (U.S. Patent No. 5,937,037) in view of Marino (U.S. Patent No. 4,850,007).

Regarding claims 3, 22, and 23, Kamel doesn't specify when the call will be connected to a customer service agent. Marino teaches a telephone advertising service that connects the user to a salesman at the moment, or later. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a connection to a salesman at any point while the user interacts with the system. This allows more flexibility for the user to decide when they would like to talk with a salesman. Claim 23 can be rejected similarly to claim 18.

Claims 33 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamel (U.S. Patent No. 5,937,037) in view of www.broadpoint.com/final/faq.htm.

Regarding claims 33 and 37, Kamel doesn't specify the ability to purchase an offered product. www.broadpoint.com (pulled from archive.org and dated at 06/14/2000) teaches the ability to push a button and purchase a product. It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow users to purchase products through the system. This capability would interest more advertisers in joining the system.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to telephone advertising systems:

U.S. Patent No. 4,916,731 to Brisson

U.S. Patent No. 5,734,702 to Sugimura

U.S. Pub No. 2001/0005372 to Cave

U.S. Pub No. 2003/0200179 to Kwan


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JEFFREY D. CARLSON
PRIMARY EXAMINER